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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,223	03/28/2001	Terry L. McMahon	6714.01	2165
25763	7590	02/24/2006		
DORSEY & WHITNEY LLP INTELLECTUAL PROPERTY DEPARTMENT 50 SOUTH SIXTH STREET MINNEAPOLIS, MN 55402-1498			EXAMINER NELSON, FREDA ANN	
			ART UNIT 3639	PAPER NUMBER

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/820,223

Applicant(s)

MCMAHON ET AL.

Examiner

Freda A. Nelson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

The amendment received on January 25, 2006 is acknowledged and entered. Claims 1-18 have been canceled. Claims 18-22 have been added. Claims 18-22 are currently pending.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 25, 2006 has been entered.

#### ***Response to Amendments and Arguments***

Applicant's arguments with respect to claims 18-22 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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1. Claims 18-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 recites the limitation "the equipment" in lines 3-4, 6, and 8, respectively. There is insufficient antecedent basis for this limitation in the claim.

Claim 19 recites the limitation "the equipment" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 20 recites the limitation "the option" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 21 recites the limitation "the options" in line 1. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 18-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Henson (Patent Number 6,167,383).

As for claim 18, Henson discloses a method in a computerized system for building a custom specification and a quote for a piece of equipment, comprising:

electronically soliciting from and selecting by a user a general specification of the equipment (col. 1, lines 18-21; col. 2, lines 61-67);

electronically soliciting from and selecting by the user different upfit options for various components for building the custom specification for the equipment (FIG. 3A-3B and FIGS. 4-6); and

automatically generating and presenting to the user a subtotal cost for the various components of the equipment and a total cost for the custom specification for the equipment. (col. 6, lines 21-34; FIGS. 3A-3B and FIGS. 4-6).

As for claim 19, Henson discloses the method of claim 18, further comprising:

Interactively selecting by the user a different option of the components (col. 6, lines 21-34; FIGS. 3A-3B and FIGS. 4-5); and

automatically updating and presenting to the user the different option and associated subtotal cost and total cost for the custom specification for the equipment (col. 6, lines 21-34; FIGS. 3A-3B and FIGS. 4-6).

As for claim 20, Henson discloses the method of claim 19, further comprising automatically updating the options and costs after an interrelated option has been selected (col. 6, lines 21-34; FIG. 6).

As for claim 21, Henson discloses the method of claim 20, wherein the options for various components include pre-engineered specifications (col. 7, line 57 through col. 8, line 6).

As for claim 22, Henson discloses the method of claim 21, further comprising generating a report showing the components selected, the subtotal cost of the components, and the total cost of the equipment. (col. 6, lines 21-34; FIG. 6).

### ***Conclusion***

3. The examiner has cited prior art of interest, for example:

1) Lee (Patent Number 6,985,876), which discloses a system and method for enabling a user of an e-commerce system to visually view and/or configure a product for purchase.

2) Lynch et al. (Patent Number 5,708,798), which disclose a method and apparatus for configuring systems.

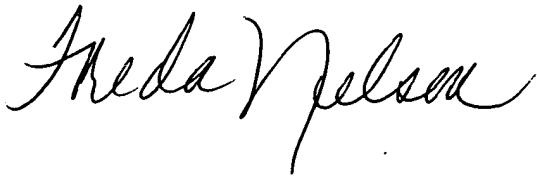
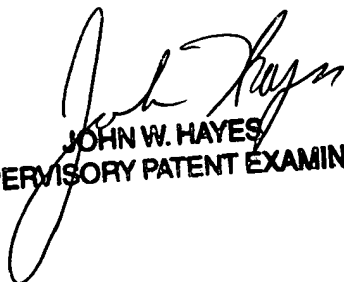
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Freda A. Nelson whose telephone number is (571) 272-7076. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FAN 02/08/2006

A handwritten signature in cursive script, appearing to read "Freda Nelson".A handwritten signature in cursive script, appearing to read "John W. Hayes".  
**JOHN W. HAYES**  
**SUPERVISORY PATENT EXAMINER**